

REMARKS

Claims 1-32 are pending in this application.

Claims 10 and 22-23 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,510. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

Claims 20 and 22-30 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,507. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

Claims 20, 22-24 and 26-30 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,508. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

Claims 1 and 17-18 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/779,422. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

Claims 1-2, 8-10, 16-26, 31 and 32 have been rejected under 35 U.S.C. §102(e) as being anticipated by Kolosov et al. U.S. Publication No. 2004/0123650 ("Kolosov et al."). This rejection is respectfully traversed.

In the Office Action, the Examiner maintains [emphasis in original]:

“... it is noted that in the description by Kolosov et al. “*most* any flowable material that may be a commercial product itself or an ingredient within a commercial product” being a candidate for screening in the combinatorial library, there is no specific exclusion of lubricating oil composition samples having a major amount of a base oil of lubricating viscosity and a minor amount of additive therein. In addition, even though there are lubricating oil compositions that are concentrates containing a major amount of a lubricating oil additive and a minor amount of a base oil of lubricating viscosity as a diluent for the concentrate, there are many commercial products such as automotive/marine lubricating oil compositions having a major amount of a base oil of lubricating viscosity and a minor amount of a lubricating oil additive therein. ... Therefore, the broad teaching of Kolosov et al. including the analysis of most any flowable material that is a commercial product encompasses both kinds of lubricating oil compositions – those that are concentrates having only a minor amount of a base oil therein and those commercial product that contain a major amount of a base oil and a minor amount of an additive, such as those commercial products taught by Carey et al. The entire disclosure of the Kolosov et al reference is considered prior art, including all embodiments under the broad teaching of lubricant oil commercial products. Without any evidence to the contrary, there is no basis to say that lubricating oil compositions containing a major amount of a base oil of lubricating viscosity and a minor amount of an additive cannot be analyzed in the combinatorial screening system taught by Kolosov et al.”

However, in order for a claim to be anticipated, a single prior art reference must disclose each and every element of the claimed invention, *either expressly or inherently*. *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987); cert. denied, 484 U.S. 1007 (1988). There is no express disclosure in Kolosov et al. of a combinatorial lubricating oil composition library comprising, *inter alia*, “a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive” as presently recited in Claim 1. There is also no express disclosure in Kolosov et al. of a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising, *inter alia*, “(a) providing a library of a vast number of a plurality of different lubricating oil composition

samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive” as presently recited in Claim 20. Rather, Kolosov et al. only disclose in paragraph 0042 that *most* any flowable material that may be a commercial product itself or may be an ingredient or portion within a commercial product can be screened or tested and goes on to state that a lubricant is one example of a genera of material of any flowable material. Certainly, this is not an express disclosure of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive. In fact, it is not seen in the Office Action of any identification of any particular column and line number in Kolosov et al. that points to an express disclosure. Thus, the Examiner is respectfully requested to point with particularity (i.e., column and line number) where in Kolosov et al. such express disclosure can be found.

With respect to an inherent disclosure, it is well established that inherency cannot be established by *probabilities or possibilities*. As summarized in *Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991), “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” As is the case here, the disclosure in Kolosov et al. that the method and system therein can analyze most any flowable material which may be a lubricant that may contain an additive does not rise to the level of an inherent disclosure. For there to be an inherent disclosure, the outcome must occur each and every time. As acknowledged by the Examiner in the Office Action, a lubricant can be a concentrate containing a major amount of a lubricating oil additive and a minor amount of a base

oil of lubricating viscosity. Moreover, a lubricant can be a grease, jelly, e.g., K-Y jelly, as well as powders, e.g., dry graphite, PTFE, etc., formulated with water and can be used as is such that all lubricants may not even require an additive or, for that matter, be used in a lubricating oil composition. Thus, Kolosov et al. cannot possibly disclose “a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive” each and every time.

Accordingly, Kolosov et al. do not inherently disclose a combinatorial lubricating oil composition library comprising, *inter alia*, “a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive” as presently recited in Claim 1. Nor do Kolosov et al. inherently disclose a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising, *inter alia*, “(a) providing a library of a vast number of a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive” as presently recited in Claim 20.

As Kolosov et al. does not expressly or inherently disclose each and every element of the claimed invention, Claims 1-2, 8-10 and 16-26 are novel over Kolosov et al. Therefore, withdrawal of the rejection of Claims 1-2, 8-10 and 16-26 under 35 U.S.C. §102(e) is respectfully requested.

Claims 3-7 and 11-15 have been rejected under 35 U.S.C. §103(a) as being obvious over Kolosov et al.

The deficiencies of Kolosov et al. discussed above with respect to the rejection of Claim 1, from which Claims 3-7 and 11-15 depend, apply with equal force to this rejection.

Kolosov et al. provide no teaching, motivation or suggestion of a combinatorial lubricating oil composition library comprising, *inter alia*, “a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive” as presently recited in Claim 1.

In contrast, Kolosov et al. simply disclose a system and method for screening a library of a multitude of genera of flowable material for rheological properties. Kolosov et al. further disclose that one of the genera of material which can be tested includes lubricants, which may or may not contain an additive. However, there are many types of lubricating oil compositions, none of which may even be a plurality of different lubricating oil composition samples comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive. Thus, nothing in Kolosov et al. would lead one skilled in the art to look to Kolosov et al. to modify the system and method for screening a library of a multitude of genera of flowable material for rheological properties disclosed therein and arrive at the presently recited combinatorial library comprising, *inter alia*, “a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive” as presently recited in Claim 1, from which Claims 3-7 and 11-15 ultimately depend. Only by using Applicants’ disclosure as a guide has the Examiner been able to piece together the claimed

invention. Accordingly, Claims 3-7 and 11-15 are believed to be nonobvious, and therefore patentable, over Kolosov et al. Thus, withdrawal of the rejection of Claims 3-7 and 11-15 under 35 U.S.C. §103(a) is respectfully requested.

Claims 27-30 have been rejected under 35 U.S.C. §103(a) as being obvious over Kolosov et al. in view of Smrcka et al., European Patent No. 1233361 ("Smrcka et al.").

The foregoing deficiencies of Kolosov et al. discussed above with respect to the rejection of Claim 20, from which Claims 27-30 ultimately depend, apply with equal force to this rejection. Smrcka et al. do not cure and is not cited as curing the above-noted deficiencies of Kolosov et al. Rather, Smrcka et al. is merely cited for its disclosure of storing test results in a data carrier. Accordingly, Claims 27-30 are believed to be nonobvious, and therefore patentable, over Kolosov et al. and Smrcka et al.

For the foregoing reasons, Claims 1-32 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



Michael E. Carmen
Reg. No. 43,533
Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
Phone: (516) 992-1848
Facsimile: (516) 739-0981
MEC